

**REMARKS/ARGUMENTS**

Review and reconsideration of the Office Action dated July 28, 2004, is respectfully requested in view of the above amendments and the following remarks.

The pending claims are Claims 1-46.

Claims 1, 4-7, 9-21 and 23-40 were withdrawn in response to the telephone restriction requirement made by the previous Examiner (Examiner Sandals) on June 10, 2003, which was made with traverse. In response to the telephone restriction requirement, Applicant provisionally elected with traverse claims 2, 3, 8, 22 and 41-46 as they read upon SEQ ID NO: 11.

However, the present Examiner, Examiner Maria Marvich, contends that neither the telephone restriction requirement nor the reason for the traversal is of record.

The present Examiner made a subsequent restriction requirement on January 28, 2004 of claims 2, 3, 8, 22 and 41-46 requiring election of one of the sequences of SEQ ID NOs: 5-16 and one of the sequences of SEQ ID NO: 1 or 2. On May 4, 2004, Applicant responded to this later restriction requirement, electing with traverse claims 2, 3, 8, 22 and 41-46 as they read on SEQ ID NO: 11 and SEQ ID NO: 2.

In the instant Office Action the Examiner, upon reconsideration, has removed the restriction requirement as between SEQ ID NO: 1 or SEQ ID NO: 2. However, The Examiner made

final the restriction requirement between SEQ ID NOs: 5-16. The Examiner has also withdrawn claims 42-46 as allegedly reading on a non-elected invention.

In view of the lack of record regarding the telephone restriction requirement and the initial withdrawal with traverse of claims 1, 4-7, 9-21 and 23-40, Applicant withdraws the withdrawal of claims 4-7, 9-21 and 23-40. Furthermore, Applicant has amended claims 4-7, 9-21 and 23-40 so as to directly or indirectly refer back to presently pending claim 2. Care has been taken to ensure that no new matter has been added. Entry of the amendment is requested. Therefore, Applicant respectfully requests the Examiner to reintroduce claims 4-7, 9-21 and 23-40 for examination.

Moreover, Applicant traverses the Examiner's withdrawal of claims 42-46. Applicant respectfully submits that claims 42-46 read upon the combination of SEQ ID NO: 11 and SEQ ID NO: 7. Combination that is within the scope of the election of SEQ ID NO: 11, to the extent that a search of SEQ ID NO: 11 satisfies the requirements for novelty and non-obviousness, no further search of SEQ ID NO: 7 would be required, and the Examiner would not be unduly burdened. SEQ ID NO: 11 and SEQ ID NO: 7 are linked so to make a non-distinct invention.

In addition to claims 2, 3, 8, 22 and 41 which according to the Examiner are under Examination, Applicant respectfully requests the Examiner to further keep under examination the reintroduced claims 4-7, 9-21 and 23-40. Moreover, in view of

the arguments presented above, Applicant requests the Examiner to reconsider his withdrawal of claims 42-46.

**Office Action**

Turning to the Office Action, the paragraphing of the Examiner is adopted.

**Sequence Compliance**

The Examiner has required inserting sequence identifiers for the 6 sequences shown in Figure 4. The sequences of Figure 4 are found in the previously submitted sequence listing.

Applicant has amended Figure 4 by moving the "Fig. 4" label to the top of the graphic and inserting the corresponding sequence identifiers according to the sequence listing.

Applicant respectfully submits that the sequences of Figure 4 have been corrected to comply with the requirements of 37 C.F.R. §§ 1.821 through 1.825. Therefore, Applicant respectfully requests the Examiner to withdraw the objection to Figure 4.

**Drawings**

The Draftsperson has objected to Figure 3 as having incorrect margins and to Figure 1 for having views that are not labeled separately.

Applicant has increased the margins in Figure 3. With respect to Figure 1, Applicant has relabeled the section

corresponding to the restriction map of the plasmid ms23 as "Fig. 1A" and the portion corresponding to the list of enzymes as "Fig. 1B". Furthermore, Applicant has accordingly amended the description of Figure 1 in page 25 of the specification.

Applicant submits herewith replacement sheets with the amended figures 1, 3 and 4. Therefore, Applicant respectfully requests the Examiner to approve the amended drawings and the changes in the specification. If necessary, Applicant will submit formal drawings of Figures 1 and 4 at the time the notice of allowance is received. Accordingly, withdrawal of the rejection to Figures 1 and 3 is respectfully requested.

#### **Specification**

The Examiner has objected to the legend of Figure 7 as failing to distinguish parts A and B. The Examiner has also required deleting from the specification, in page 25, lines 4-9, embedded hyperlinks or other form of browser executable code.

Applicant has amended the description of Figure 7 in page 26 of the specification to indicate that Figure 7a and Figure 7b refer to two different experiments and that Figure 7b includes some additional constructs that have been investigated. Applicant has also amended the specification to delete the hyperlinks from the first paragraph in page 25. Applicant has not added new matter.

Applicant respectfully submits that the defects in the specification noted by the Examiner have been corrected.

Therefore, Applicant respectfully requests the withdrawal of the objections to the specification.

**Oath/Declaration**

The Examiner alleges that under 37 C.F.R. § 1.67(a) the oath or declaration previously submitted is defective. A new oath or declaration identifying the instant application by application number and filing date is required.

Applicant submits a new oath or declaration with the proper application number and filing date under 37 C.F.R. § 1.67(a). Applicant respectfully request the Examiner to approve the oath or declaration submitted herewith.

**Claim Objections**

The Examiner has objected to claim 41 under 37 C.F.R. § 1.75 as being a substantial duplicate of claim 2. The Examiner's position is explained in the second paragraph of page five of the office action.

The Examiner also objected to claims 2, 3, 8, 22 and 41 as allegedly encompassing non-elected subject matter.

Applicant has deleted claim 41. Applicant notes that objections and rejections to claim 41 are moot in view of its deletion.

Applicant has amended claims 2, 3, 8 and 22 to encompass only matter directed to SEQ ID NO: 11 or SEQ ID NOs: 1 and 2.

Applicant therefore respectfully requests the Examiner to withdraw the objections to claims 2, 3, 8 and 22.

**Claims Rejections - 35 USC § 112, second paragraph**

The Examiner has rejected claims 2, 3, 8, 22 and 41 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 2, 3, 8, 22 and 41, the Examiner contends that the recitation "local gene expression" is unclear. The Examiner position is explained in the second paragraph of page 6 of the office action.

With respect to claim 8, the Examiner alleges that the limitation "at least two of said *cis*-acting elements" lacks sufficient antecedent basis in claim 2.

With respect to claim 22, the Examiner alleges that the metes and bounds of "A *cis*-acting element" are unclear. The Examiner position is found in paragraph 4 of page 6 of the office action.

Applicant respectfully submits that the term "local" is sufficiently defined in the specification at page 3, first full paragraph. Since the specification clearly set forth the meaning of "local gene expression", this term is not unclear as referred in claims 2, 3, 8, 22 and 41. Therefore Applicant

respectfully requests the Examiner to withdraw the rejection to claims 2, 3, 8 and 22 under 35 U.S.C. § 112, second paragraph.

Applicant has amended claim 2 to read "two or more *cis*-acting elements" instead of the recitation "at least one *cis*-acting element". Support for "two or more *cis*-acting elements" can be found in the specification at page 4, lines 2-4 of fifth paragraph. Applicant has not added new matter.

Therefore, claim 2, as amended, has sufficient antecedent basis for the limitation "at least two of said *cis*-acting elements" in claim 8. Consequently, Applicant respectfully requests the Examiner to withdraw the rejection to claim 8 under 35 U.S.C. § 112, second paragraph.

Applicant has amended claim 22, which recites "A *cis*-acting element", to indicate that these terms refer to SEQ ID NO: 11. Therefore, Applicant submits that claim 22, as amended, is not unclear. Applicant respectfully requests the Examiner to withdraw the rejection to claim 11 under 35 U.S.C. § 112, second paragraph.

**Claim Rejections - 35 USC 102 § 102**

The Examiner rejected claims 2, 22 and 41 under 35 U.S.C. § 102(b) as allegedly anticipated by Van de Locht et al. (Embo J. 1990, vol 9(9):2945-2950). The Examiner contends that Van de Locht et al. teaches a chimeric promoter comprised of the sequence found in SEQ ID NO: 11 and the core of CHS promoter which comprises those elements necessary to initiate

transcription i.e. TATA Box (page 2948, column 1, paragraph 1). The Examiner further notes that the portion of PR2 promoter used in the chimeric construct shown in Figure 6 extends from -168 to -43 which covers the region of SEQ ID NO: 11 as highlighted in Figure 3.

In response, Applicant respectfully submits that Van de Locht et al. identifies a DNA sequence within the PR2-promoter from position -168 to position -52 as being necessary for strong elicitor-inducibility of the promoter (See Van de Locht et al at Abstract and page 2947, left hand column, last paragraph). Furthermore, from the deletion analysis of the promoter (See id. e.g., Figures 5 and 6), Van de Locht et al. teaches that the sequence between positions -168 and -108 is critical for both elicitor-inducibility and the strength of the promoter. On the other hand, the sequence from position -108 to position -52 was considered to mediate elicitor-dependant expression only at a low level (See id. at page 2149, left-hand column, last sentence of the third paragraph and first two sentences of the fourth paragraph).

In the present application, the D-Box sequence (SEQ ID NO: 11) is contained in the promoter sequence shown in Figure 3 of Van de Locht et al. from position -76 to position -46. This means that the D-Box sequence of the present invention is not within a sequence between positions -168 and -108, which is described by Van de Locht et al. as being the most important. Further, the D-Box sequence of the present invention is not even within the sequence range of positions -168 and -52. Thus, Van



de Locht et al. teaches the skilled artisan away from the D-Box sequence (SEQ ID NO: 11) of the present invention.

The D-Box sequence of the present invention (from position -76 to position -46) has been shown later by Rushton et al. (Rushton et al., *The Plant Cell*, 14:749-762 (2002)) that in the form of a tetramer, it mediates a strong pathogen-inducible transcription, whereas the sequence between positions -76 and -52, albeit being pathogen-inducible, only forms a weak promoter. Rushton et al. shows that the sequence between position -76 and -52 is 30 times less strong as a promoter as compared with the sequence between position -76 and -46 (See Rushton et al. at the section bridging pages 755 and 756, as well as, Figure 9; showing that the promoter "4xD" with the additional 6 bases, is 30 times stronger than the promoter 4xD short").

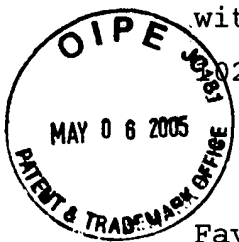
Van de Locht et al. does not teach the *cis*-element D-Box having the sequence shown in SEQ ID NO: 11, as presented in the instant invention. Van de Locht et al. does not teach either a chimeric promoter construct which contains two of the D-Box elements characterized by SEQ ID NO: 11.

Applicant respectfully submits that in view of above, and the amendment to claim 2 to recite "two or more *cis*-acting elements", Van de Locht et al. does not anticipate claims 2 and 22.

Therefore, Applicant respectfully requests the Examiner to

ATTORNEY DOCKET NO.: 4038.001

withdraw the rejection to claims 2 and 22 under 35 U.S.C. §  
102(b).



Applicants believe that all the claims are now allowable. Favorable consideration and early issuance of the Notice of Allowance are respectfully requested. Should further issues remain prior to allowance, the Examiner is respectfully requested to contact the undersigned at the indicated telephone number.

Respectfully submitted,

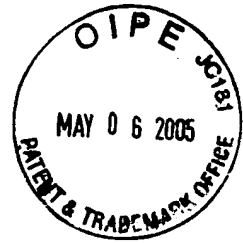
A handwritten signature in black ink, appearing to read "Stephan A. Pendorf", written over a horizontal line.

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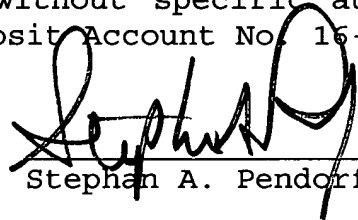
**Enclosures:** 15 replacement sheets (Drawings), Oath/Declaration,  
Rushton et al.



**CERTIFICATION OF MAILING AND AUTHORIZATION TO CHARGE**

I hereby certify that a copy of the foregoing AMENDMENT A for U.S. Application No.: 09/831,272 filed August 13, 2001, was deposited in first class U.S. mail, postage prepaid, addressed: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on **May 4, 2005**.

The Commissioner is hereby authorized to charge any additional fees, which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account No. 16-0877.

  
Stephan A. Pendorf

U.S. Patent Application No. 09/831,272  
AMENDMENT A

ATTORNEY DOCKET NO.: 4038.001

**IN THE DRAWINGS**

Please replace Figures 1, 3 and 4 with the attached amended  
Figures 1A, 1B, 3 and 4.